

REMARKS

Applicant maintains and incorporates by reference herein those arguments previously advanced on pages 2 through 5 of Response C, filed June 28, 2005. Applicant respectfully requests that the Examiner reconsider those arguments, and withdraw the outstanding Section 103 rejection. Additionally, although Applicant does not agree that the Examiner's proposed combination is proper, or that claims 1-5, 8-9, 11, 14, and 16 read upon the Examiner's proposed combination, Applicant has amended the independent claims solely in the interests of expediting prosecution. Accordingly, Applicant respectfully requests that the Examiner consider the following additional arguments, and expansions upon previous arguments.

Applicant submits that the Examiner's comments in the Advisory Action do not answer the meritorious arguments previously advanced by Applicant traversing the outstanding rejection, nor do these remarks justify the Examiner's refusal to withdraw the outstanding rejection. Applicant submits that the Examiner has still not established a *prima facie* case of obviousness against the independent claims of the present invention. The prior art does not show each and every feature of the present invention, and the Examiner still has not cited to any objective teaching or suggestion within the prior art references themselves for making the proposed combination.

The Examiner correctly acknowledges that there "exists a functional relationship between the four hierarchies [recited in the present invention] in that the first hierarchy must occur before the second hierarchy, the second hierarchy before the third

hierarchy, and so on.” Accordingly, by the Examiner’s own statements here, the appropriate rejection of the present invention under Section 103 should not only include relevant teachings or suggestions corresponding to the individual hierarchies, but also an additional teaching or suggestion to organize these hierarchies in the order recognized by the Examiner. In the present case, however, the Examiner still does not cite to any objective teaching or suggestion within either cited prior art reference that discloses the specific recited order of the present invention.

For example, the Examiner recognizes that the base Wheat reference does not teach or suggest the first and second scheduling hierarchy of the present invention. (Page 3 of Paper No. 20050222). The Examiner relies only upon the da Silva reference for teaching the first and second hierarchies of the present invention. However, even if the Examiner were correct that da Silva teaches such features (which Applicant does not concede), the Examiner has cited no teaching or suggestion from either reference that teaches that such “first and second hierarchies” in this particular order, and that are also executed before the “third and fourth hierarchies” that the Examiner asserts to be taught by Wheat. Again, the Examiner’s own comments recognize that this particular recited order is an affirmative limitation of the present claims.

It is also significant to note that the Examiner does not assert that da Silva also teaches the “third and fourth hierarchies” the Examiner finds in Wheat. And without this additional teaching in da Silva, the limitations of the claims of the present invention cannot be met. Because the Examiner even acknowledges that Wheat does not teach the first and

second hierarchies of the present invention, da Silva then must, in addition to teaching such hierarchies, further teach that these hierarchies are in the same order as the present invention, and prior to the hierarchies the Examiner asserts to be present in Wheat. Because the Examiner has not cited to any objective support from the references that meet these limitations, the rejection must be withdrawn.

Furthermore, with respect to the Examiner's proposed combination itself, the Examiner's remarks in the Advisory Action still fail to justify the proposed combination under Section 103. It is a well settled principle of patent law that the Examiner is required to provide some objective support on the record that establishes the teaching or suggestion for combining the specific elements cited from one prior art reference with the specific elements cited from another. In the present case, however, the Examiner has still not met this burden.

The Examiner's entire justification for his assertion that the motivation for the proposed combination comes from the prior art is: (1) "both references teaches (sic) the scheduling of a parallel job (application) having a plurality of tasks (data cells) to a plurality of processors"; and (2) that da Silva reference (in the Abstract) teaches the goal of providing a "flexible simultaneous scheduling of multiple parallel jobs with different characteristics." Neither assertion, however, provides any teaching or suggestion to combine two particular hierarchies from da Silva with two different particular hierarchies from Wheat, and in the precise order recited in the independent claims of the present invention.

With respect to the Examiner's first rationale, Applicant did not dispute that either of the Wheat or da Silva references was analogous art. The fact alone though, that a

prior art reference is in the same field of art as the present invention, is not sufficient by itself to justify the combination of such a prior art reference with any other prior art reference in the same field of art. The Examiner is instead required to cite to some objective teaching or suggestion within one or more of the prior art references for the motivation to combine these particular prior art references, and in such a way as to meet the exact limitations of the claimed invention. In the present case, however, the Examiner appears to have justified the combination merely on the basis that the two cited references “are analogous art.” This rationale fails to meet the requirements of a Section 103 rejection based on a combination of references, and thus the outstanding rejection should be withdrawn for at least these additional reasons.

With respect to the Examiner’s second rationale, nothing in the cited Abstract from da Silva teaches or suggests anything regarding how or why to combine two distinct hierarchies in the da Silva reference with two different hierarchies in Wheat reference, and in the exact order recited in the present invention (and acknowledged by the Examiner). Applicant never disputed that da Silva described “the flexible simultaneous scheduling of multiple parallel jobs with different characteristics.” Applicant does dispute however, that this broadly worded objective from da Silva, by itself, does in any way teach the required objective motivation to combine da Silva with Wheat. Nothing in this portion of da Silva’s Abstract mentions anything about respective scheduling hierarchies.

Moreover, da Silva’s Abstract is entirely silent regarding the particular order of hierarchies recited by the claims of present invention. The Examiner is required to provide

objective support for the precise combination of features that he proposes can be made, and not merely for a broad objective that may be accomplished by one of the references. The objective motivation must teach or suggest the actual limitations recited by the claimed invention. Because no such objective motivation has been provided by the Examiner on the record, the outstanding Section 103 rejection should be withdrawn for at least these additional reasons as well.


Although it should have been clear to anyone skilled in the art when reading the claims of the present Application in light of the Specification, Applicant has nevertheless amended the independent claims to further emphasize that jobs are arranged according to the respective order of recited hierarchies. This grammatical amendment emphasizes the clear deficiencies, discussed above, within the cited prior art references and the outstanding rejection. Neither prior art reference teaches the particular order of hierarchies recited by the present invention.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-5, 8-9, 11, 14, and 16, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Josh C. Snider", written over a horizontal line.

Josh C. Snider

Registration No. 47,954

Customer No. 24978

July 28, 2005

300 South Wacker Drive

Suite 2500

Chicago, Illinois 60606

Telephone: (312) 360-0080

Facsimile: (312) 360-9315

P:\DOCS\1503\65173\9D0048.DOC